

REMARKS

Claims 1-25 are pending in the instant application. In response to the restriction requirement, group I consisting of claims 1-17 is elected and claims 18-25 are withdrawn without traverse. Claims 1, 3-6, and 8-17 are amended herein for clarity. Applicant wishes to thank Examiner Paul Fisher for his detailed analysis of the pending claims. Reconsideration of the rejections of the claims is respectfully requested in light of the amendments and remarks contained herein.

Claim Rejections 35 U.S.C. § 112

Claims 1-17 stand rejected under 35 U.S.C. § 112 as being indefinite. The claims have been amended herein for clarity.

Claim 1 has been amended to recite a method for evaluating potential sales and business opportunities by calculating metrics that include a projected tire sales for the automotive center. The claim has been further amended to clarify data flows by using more consistent terms and correcting incorrect antecedent bases. It is respectfully submitted that it is now clear that the data that is collected is used in calculating the maximum expected number, which is then used in determining a tire sales goal. The tire sales goal is then used in calculating the projected tire sales for the automotive service center, as recited in the preamble. It is respectfully submitted that these amendments are for clarification, having little effect on claim scope, and are supported throughout the specification. In light of these clarification amendments, it is respectfully requested that the § 112 rejection of claim 1 be withdrawn.

Similar amendments have been made to claim 12 in reciting a method of evaluating potential sales and business opportunities by calculating metrics that include a business

opportunity metric. In light of these clarification amendments, it is respectfully requested that the § 112 rejection of claim 12 be withdrawn.

Claims 3 and 13 are rejected for being indefinite as to how the new data fits into the independent claims from which they depend. Claims 3 and 13 have been amended to clarify that the new data is utilized in calculating a net profit, as described in paragraph [0050]. In light of these clarification amendments, it is respectfully requested that the § 112 rejections of claim 3 and 13 be withdrawn.

Claims 6, 8, 15 and 17 are rejected for being indefinite as to how the recited calculations tie to the limitations of the claims from which they depend. Claims 6 and 15 have been amended to recite that the recited metrics being calculated use the projected tire sales recited in the parent claims. Claims 8 and 17 have been amended to clarify that the claims are describing calculation of an additional metric, as recited in the preamble of their parent claims. In light of these clarification amendments, it is respectfully requested that the § 112 rejection of claim 6, 8, 15, and 17 be withdrawn.

Claims 4, 5, and 14 are rejected for being indefinite based on their use of the term, “about.” Claims 4, 5, and 14 have been amended to refrain from using the term “about.” In light of these amendments, it is respectfully requested that the § 112 rejections of claims 4, 5, and 14 be withdrawn.

Claims 10 and 11 are rejected for being indefinite based on their usage of the terms warranty factor and loyalty variable, respectively. It is respectfully submitted that the warranty factor is described in detail in paragraph [0065], and the loyalty variable is described in detail in paragraph [0068]. These portions of the specification clearly define the terms, their determination, and example values. In light of these portions of the specification, it is

respectfully submitted that claims 10 and 11 are clear, and it is respectfully requested that the § 112 rejections of claims 10 and 11 be withdrawn.

Claim Rejections – 35 U.S.C. § 101

Claims 1-17 stand rejected under 35 U.S.C. § 101 as failing to recite patentable subject matter. In light of these rejections, independent claims 1 and 12 have been amended. Claims 1 and 12 now recite the use of one or more data processors and a computer-readable memory throughout. Additionally, the subject matter of the claims further recites features involving cars, their tires, and actual numbers of cars serviced by the service center having tires a tire tread depth less than a tread depth threshold. In light of these amendments, it is respectfully requested that the § 101 rejections of claims 1-17 be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 1-5, 7, and 12-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Burris (U.S. Patent Application No. 2003/0208394) in view of Byrd, “Manage Your Inventory in Excel,” (www.computorcompanion.com). In rejecting claim 1, the office action appears to argue that the method of claim 1 recites general business calculations, with the details as to what types of data are being input into the general business calculations being non-functional and, therefore, accorded no patentable weight.

Applicant strongly disagrees with this argument and respectfully submits that the references cited do not include sufficient evidence for a proper § 103 rejection of the amended claims. For example, claim 1 recites calculating a maximum expected number of tires to be sold for each carline per period, where calculating the number involves multiplying an average

number of repair order requests per time period by the number of days the service center is open per time period multiplied by four multiplied by a tire tread index. The office action cites to paragraph [0025] of Burris as teaching this claim feature. Paragraph [0025] of Burris states,

[0025] Due to the flexibility of the system, and the large amount of information entered into it relating to virtually all business aspects of the manufacturer, a wide range of reports is readily available to a user. FIG. 3 lists, in a hierarchical structure, examples of some of the types of reports that can be generated. Forecasting reports can be tailored to predict future sales, production requirements and necessary inventory. Further, the scope of these predictions can be adjusted to varying levels of detail. This allows for predictions relating to a class or range of products, or if greater detail is desired, only to one specific product, component or raw material. Additionally, this prediction data can be further broken down based on qualifiers. Several examples include qualifiers relating to a unit of time, or a specific customer, part, product line or manufacturing plant. Consequently, very specific and detailed forecasts can be now generated, such as an expected amount of raw material required per customer per plant per month.

This paragraph states that a number of different reports may be generated at a number of different levels of detail. There are no details in this portion of Burris detailing a mechanism for calculating these reports at all, let alone a teaching of the detailed calculating step of claim 1. Burris at most says that a future sales report may be calculated. Because Burris in combination with Byrd fails to teach or suggest the detailed steps of calculating a maximum expected number of tires to be sold for each carline per period, where calculating the number involves multiplying an average number of repair order requests per time period by the number of days the service center is open per time period multiplied by four multiplied by a tire tread index, it is respectfully requested that the § 103 rejection of claim 1 be withdrawn.

It is further submitted that the § 103 rejection of claim 1 should be withdrawn because the cited references fail to teach the very specific tire tread index recited in the calculating a maximum expected number step. The office action attempts to sidestep the requirement of having to cite to a reference teaching or suggesting such an index by stating that the index is non-

functional descriptive material that should be afforded no patentable weight. It is respectfully submitted that the tire tread index is clearly not non-functional because it is used in calculating the maximum expected number of tires to be used. The office action fails to cite to a teaching or suggestion of any index at all, let along a tire tread index, in calculating a maximum expected number of tires to be sold. Because the recited index is clearly functional in that it is utilized in calculating a maximum expected number of tires, it is respectfully submitted that the office must cite to the use of such an index in a calculation of a maximum expected number of tires to be sold, as recited in the claims. Because the office action fails to cite to the use of any index at all in discussing this portion of the claim, it is respectfully requested that the § 103 rejection of claim 1 be withdrawn.

Further, the office action presents a hypothetical scenario on page 11 of the office action. It is respectfully submitted that this hypothetical is not substantial evidence as is required for fact finding under the Administrative Procedures Act. It is respectfully submitted that this scenario is not a well-known fact capable of instant and unquestionable demonstration that is eligible for an official notice, as evidenced by the “could” language in the hypothetical. Because this scenario is not supported by substantial evidence and is not eligible for entry into the record by official notice, it is respectfully requested that the hypothetical be withdrawn from the record. Because the office action relies on improper evidence in finding the claims obvious, it is respectfully requested that the § 103 rejection of claim 1 be withdrawn.

Similar features are recited in independent claim 12, and similar portions of the references are cited in referencing the similar features. Thus, it is respectfully requested that the § 103 rejection of claim 12 be withdrawn for similar reasoning as offered for claim 1.

Claims 4, 5, and 14 recite specific ranges that the office action ignores as being non-functional descriptive material. It is respectfully submitted that the office cannot properly ignore recited ranges in this manner. In fact, the MPEP contains several sections specifically devoted to the examination of ranges (*e.g.*, 2131.03 and 2144.05). The recited ranges are no different than other ranges recited in other applications. They are functional limitations, and it is respectfully submitted that these ranges must be considered. Because the cited references fail to deal with tires at all, let alone tire tread indexes in the very specific ranges recited, it is respectfully requested that the § 103 rejections of claims 4, 5, and 14 be withdrawn.

Several other claims are rejected through the use of hypotheticals. Such hypotheticals are found in the rejections of claims 3, 4, 5, 13, 15, and 16 and may be found elsewhere throughout the office action. These hypotheticals include language such as “could” and “would” that clearly identify these statements as not being statements of incontrovertible facts. Because these statements are not proper taking of official notice nor are substantial evidence upon which to base a § 103 rejection, it is respectfully requested that the § 103 rejections of claims 3, 4, 5, 13, 15, and 16 be withdrawn for reliance on insufficient and improper evidence. Applicant reserves the right to further argue this issue with respect to other claims in future correspondence.

Claims 8, 10, 11, 16, and 17 are rejected under § 103 based on takings of official notice along the lines of, “the Examiner is taking official notice that it is old and well known to make various calculations and that the calculations would include such calculations such as...” Applicant disagrees that these statements are incontrovertible facts. While certain metrics *may* be known, claims 8, 10, 11, 16, and 17 provide detailed descriptions on how those metrics are generated. The office action includes little discussion about why the steps recited in the claims

for generating the recited metrics are known as incontrovertible facts. The fact that a metric exists does not mean that the recited steps for generating the metric are known, especially when the metric may be generated in a myriad of different ways. Applicant submits that the recited steps for generating the metrics recited in the claims are not known and requests citations to substantial evidence, as required by the Administrative Procedures Act. Because these rejections fail to rely on substantial evidence as required, it is respectfully requested that the § 103 rejections of claims 8, 10, 11, 16, and 17 be withdrawn.

Claim 26 has been added. Claim 26 recites further details of the tire tread index, where the index is calculated by measuring a tread depth for a plurality of cars, determining a number of the cars having a tread depth less than a threshold, and determining an index based on the number of cars having a tread depth less than the index and the total number of cars in the plurality of cars. This claim is supported throughout the specification including at paragraphs [0026]-[0028]. Because none of the cited references deal with tire tread at all, and claim 26 teaches features specific to tire tread including the measuring of a tread depth, it is respectfully submitted that claim 26 is allowable.

It is noted that the assignee has not presented arguments with respect to certain of the dependent claims in the instant application. This is done without prejudice to the assignee's right to present arguments with respect to each of the claims at any point in the future. Further, because each of the dependent claims in the application depends from a base claim that is itself allowable, the dependent claims are allowable for at least the reasons set forth with respect to the independent claims.

CONCLUSION

For the reasons set forth above, the pending claims of the instant application are allowable. The assignee respectfully requests that the examiner pass this case to issuance.

By: 

Matthew W Johnson
Reg. No. 59,108
JONES DAY
500 Grant Street
Suite 4500
Pittsburgh, PA 15237
(412) 394-9524